

Figures

Figures 1 through 6 with proposed changes shown in red are attached to this Reply. Submission of formal drawings will follow a finding of allowable subject matter. The attached figures do not enter new matter.

With respect to the Examiner's requirement that top frame member 19 in FIG. 1 should be shown as a hidden line, it is noted that such a modification does not add to the understanding of the invention and is not *required* (see, for example, 37 C.F.R. 1.84(m): use of shading is encouraged if it aids in understanding the invention). It is respectfully submitted that such a modification does not add to the understanding of the invention and would only serve to increase the cost of prosecuting this application. Reconsideration of this objection is requested.

With respect to the Examiner's requirement that reference characters 16 and 17 in FIG. 5 require lead lines, it is respectfully submitted that this is incorrect. In accordance with the "Guide for the Preparation of Patent Drawings" (copyright 1993) by the Patent and Trademark Office, use of underlined reference numbers on an identified surface is acceptable. See, for example, pages A-4-8 and A-4-9 in the above referenced Patent Office publication which explicitly indicates that use of underlined reference numerals is proper and in conformance with 37 C.F.R. 1.84(p)(q).

Non-Obviousness Supported by Long Felt and Unsolved Need

In light of the aforementioned telephone interview, an additional Declaration from James Epps is attached to this Reply that further supports the Applicant's position that use of upwardly focused proximity sensors is not obvious in light of prior art (see particularly paragraphs 7 through 10).

In combination with the prior filed Declarations of Ray Epps (see particularly paragraphs 8, 9 and 10) and Cheri Roell (see particularly paragraphs 7 and 9), this Declaration is believed to conclusively establish (1) a long felt but unsolved need in the fast-food service industry for a service window that avoids

an excessive number of false opening operations and (2) a nexus between the claimed use of upwardly focused proximity detectors and the solution to this long felt need. See, in particular, paragraphs 7 through 9 of the James Epps Declaration. (True copies of prior filed Declarations from C. Roell and R. Epps are attached to this Reply for the examiner's convenience.)

With respect to the prior filed Declaration by Steve Halliburton regarding non-obviousness, it is respectfully submitted that the Examiner has substituted his belief of what constitutes non-obviousness for that of a skilled practitioner in the field -- see paragraph 11 in the Halliburton Declaration. (A true copy of the prior filed Halliburton Declaration is attached to this Reply for the examiner's convenience.) The Examiner's reconsideration of this matter in light of these remarks and M.P.E.P. 2144.08(II)(B) is requested.

Section 103 Rejections

The Examiner has rejected claims 1 through 5, 7, 9 and 10 "under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of figure 5 in view of Boiucaner." (See Office Action, pages 3 and 4.)

It is respectfully submitted that Boiucaner does not teach, suggest or motivate the use of upwardly focused proximity detectors as recited in independent claims 1, 2 and 3. Binding legal precedent requires that the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991); *see also* M.P.E.P. 2143. If the Examiner believes that such a motivation exists, the Examiner is requested to indicate where in Boiucaner such a suggestion is found. If the Examiner is relying on personal knowledge that one of ordinary skill in the art would have combined the cited references as alleged, the Examiner is requested to provide an Affidavit so stating in accordance with 37 C.F.R. 1.104(d)(2) and M.P.E.P. 2144.03.

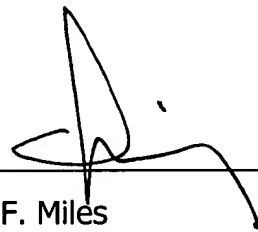
Claims 4, 5, 7, 9 and 10 depend from one of claims 1, 2 and 3 and are, therefore, allowable for at least the same reasons.

CONCLUSIONS

Reconsideration of pending claims 1 through 5, 7, 9 and 10, in light of the above remarks and supplemental declaration and substitute figures is respectfully requested. If, after considering this reply, the Examiner believes that a telephone conference would be beneficial towards advancing this case to allowance, the Examiner is strongly encouraged to contact the undersigned attorney at the number listed.

9-10-1999

Date



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